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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,034	06/01/2001	Dennis Krivohlavek	KRI955/971071D	3855

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EXAMINER

LIPMAN, BERNARD

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 11/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/570,511

Applicant(s)

Krivohlavek

Examiner

Szekeles

Group Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 10/05/01
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-36 and 45 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 13 is/are allowed.
- ☒ Claim(s) 1-12 and 14-36 and 45 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_ ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other \_\_\_\_\_

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## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: On pages 20-22 the unexplained abbreviation "TFOT" appears. All abbreviations have to explained in the specification. Appropriate correction is required.

2. The use of the trademarks "Butaphalt B 720" on page 24 and "E-4189" on page 40 has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

3. Generic terminology means chemical composition. All trademarks have to be identified by chemical composition. Functional identification, i.e. "soap solution" is insufficient.

4. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179

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USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

5. The attempt to incorporate subject matter into this application by reference to the publications on pages 20 and 27-32 is improper, because they are publications, not U.S. Patents or U.S. Patent Applications. The examiner assumes that included by reference means incorporated by reference.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Insertion into the specification of the following is required: The reaction product of the redox reaction in claim 1 (final version), the aqueous dispersions of claim 14, the polymer with any functional end group in claim 15, the metal M selected from all the Groups in claim 21, the metal M selected from the elements of claim 22, the metal A selected from all the Groups of claim 23, the cationic soap of claims 34 and 35 and the saponified amine or amines of claims 35 and 36.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-11, 14-37 and 45 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make

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and/or use the invention. The last two lines of claim 1 are incomprehensible. A redox reaction cannot be an ingredient in a composition.  $M(A)_x$  is not an anion, but a salt, if M is a metal and  $MH_x$  is not a salt but an alloy, if M and H are both metals.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 21-25 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. "Said metal M" has no antecedent basis in claim 14. (Claims 21-22). Phosphorous (sic) and the ammonium radical are not metals. (Claim 23). The Group of Negative Ions or the Halide Group of Negative Ions, members of Group VIIA and O, S, N, P, As, C and Si of Groups IVA, VA and VIA are not metals. (Claim 23). "Said metal A" has no antecedent basis in claim 14 and A is supposed to be an anion. (Claim 23). The "said phenol" has no antecedent basis in claim 1. (Claim 27).

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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13. Claim 12 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Krivohlavek 5,256,710.

14. Krivohlavek discloses combining polymers with asphalt and adding phenol-aldehyde resin and mixing, in claim 1, while the addition of sulfur can be found in claim 5. Applicant's claims are not novel.

***Allowable Subject Matter***

15. Claim 13 is allowed.

***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (703) 308-2460. The examiner can normally be reached on Tuesday-Friday from 7:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599 or 5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



**Peter Szekely  
Primary Examiner  
Art Unit 1714 .**